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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,481	01/20/2006	Pierre Barberis	12467/8	2123
23280 7590 01/12/2009 Davidson, Davidson & Kappel, LLC 485 7th Avenue 14th Floor New York, NY 10018				
EXAMINER PALABRICA, RICARDO J				
ART UNIT 3663		PAPER NUMBER		
MAIL DATE 01/12/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,481

Applicant(s)

BARBERIS ET AL.

Examiner

Rick Palabrica

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 12/15/08, which traversed the rejection of claims in the 9/11/08 Office action, has been entered.

Response to Arguments

2. Applicant traversed the examiner's use of Mardon et al. for the teaching on "the performance of a single rolling operation without intermediate annealing." Applicant argues that "[o]ne of skill in the art would not use the teaching of tubes such as Mardon et al. to combine with the flat arrangements of APA." To support this argument, applicant further states that "[i]t is known by one of skill in the art that the deformation process and annealing features are more complex with tubes than with sheet arrangements." Underlining provided.

The examiner disagrees.

Based on applicant's own admission that tubes have more complex attributes than sheets, an artisan would have even more incentive to try the known option (i.e.,

single rolling without intermediate annealing) to a flat arrangement, particularly in the light of teachings in Mardon et al. and his own knowledge (as admitted by applicant). If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. Note that Mardon et al. has been successfully applied to a more complex structure than a flat arrangement. Additionally, adopting this known option for a flat arrangement would offer the advantage, e.g., of being simpler and therefore less costly and less time consuming process.

3. Applicant also traversed the examiner's position that the reduction ratio is a design requirement that depends on the final dimensions of the final product. Applicant argues that "[t]he final product dimensions are only one parameter of a combination of features which define the process and cannot be isolated just because its choice would depend on the final dimensions required for the product." Underlining provided.

The examiner disagrees.

Based on applicant's own admission that the final dimensions of the final product is one parameter among a combination of other factors that define the process, then the reduction ratio is a matter of optimization in addition to being a matter of design, as further explained below.

First, some of the other factors that define the process may have an opposing effect on the process results compared to the effect of the final dimensions of the final product. Thus, there is a need to properly select these final dimensions relative to the other factors in order to achieve optimum results.

Second, MPEP 2144.05.II (Optimization) requires that a particular parameter be recognized as a result-effective variable, i.e., a variable which achieves a recognized result. The final dimensions of the final product are clearly result-effective variables, which achieve varying degrees of benefits/impacts. Different final dimensions will affect differently the attributes of the final product (e.g., structural strength, thermal conductivity, neutron absorption), but largely predictably.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 18, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA) in view of Mardon et al. (U.S. 5,735,978) alone or in combination with either one of Graham (U.S. 3,336,201) or Katz (U.S. 3,776,508).

As to claims 16, 18, 22, and 24-26, the reasons are the same as those stated in section 4 of the 12/15/08 Office action, as further clarified in sections 2 and 3 above, which reasons are herein incorporated.

As to claim 23, just like claim 22, the reduction ratio of 5% to 10%, this is matter of design, as discussed in section 4 of the 12/15/08 Office action and in section 3

above. This reduction ratio is also a matter of optimization, as discussed in section 3 above.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rick Palabrica/
Primary Examiner, Art Unit 3663

January 6, 2009